

Remarks

Claims 1-17 were pending in the Office action. Claims 1-5, 9, 11-16 have been amended for clarity. Claim 7 has been cancelled. Claims 1-6, and 8-17 are currently pending in the application. A substitute specification is submitted herewith. No new matter has been added by the amendments. Reconsideration is respectfully requested.

Objection to the Drawings

The drawings have been objected to because a reference character "14" has been used to designate both a computer and the storage medium. In response, Applicant respectfully submits that a replacement figure, a marked-up version of the replacement figure, and a Letter to Chief Draftsperson is included herewith. In the replacement drawing, reference character 14 was deleted from Fig. 1 and reference character 17 was added to reference data.

The drawings were also objected to for failing to include the reference character "17" mentioned in the description. The amendment should also overcome this objection. Further, reference character 16 was amended to refer to the optically readable storage medium, instead of the data.

The drawings were also objected to because reference character "61" was used to designate both a public key (page 9, line 5) and a step in Fig. 4 (page 9, line 36). Applicant submits that in the substitute specification "b1" designates the public key, instead of reference character 61. Therefore, the drawing need not be amended.

The drawings were objected to because reference signs 43 and 167 were not mentioned in the specification. Applicant submits that the substitute specification includes reference sign 43.

In a telephone conversation with the Examiner on May 6, 2004, Applicant indicated that it appeared that reference

sign 167 does not appear in the drawings. The Examiner suggested that Applicant point out that reference sign 167 does not appear in the drawings, in response to the objection.

Therefore, Applicant respectfully submits that the objection to the drawings should be withdrawn.

#### Objection to the Specification

The disclosure was objected to because of an informality. The term "b1" located at page 9, line 13, of the original specification has been amended in the substitute specification to recite "by".

Further, a substitute specification having double-spaced lines is submitted herewith. Applicant respectfully submits that, as outlined in 37 C.F.R. section 1.52(b)(2), the 1 ½ spacing of lines in the specification as filed is permissible. Therefore, Applicant submits the double-spaced substitute specification as a courtesy to the Examiner.

Additionally, the substitute specification includes changes outlined in the Objection to the Drawings section of this response.

#### 35 U.S.C. § 112

Claims 1-17 were rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

In response, claim 1 has been amended to include the word "and" preceding the last element of the list.

Claim 2 has been amended to recite "said cryptographic processing unit".

Claims 5 has been amended to recite "an" and claims 13 has been amended to recite "are".

Claim 7 has been cancelled.

Further, as requested by the examiner, the claims have been revised so that, to the best of Applicant's

knowledge, they include identical names for every element each time it is mentioned.

Rejection Under 35 U.S.C. § 103

Claims 1-17 were rejected under 35 U.S.C. § 103 as being unpatentable over Valerij et al. This rejection is respectfully traversed.

Applicant respectfully submits that Valerij et al. fail to teach or suggest "each information carrier having a passive data storage medium but lacking any data processing unit...", as recited in independent claim 1. With regard to this claimed element, the Examiner states:

Valerij discloses the carrier having a processing circuit (column 1 lines 8-9), which carries out cryptographic functions for the system. The circuit exists in the card, as opposed to being in the drive, to authenticate the drive (column 5 lines 57-65). Removing this security check in a secure system, with tamper-resistant drives to save money would be obvious to one of ordinary skill in the art. Office action, at 5.

Applicant respectfully submits that it is improper to find obviousness "by limit[ing] the focus of the inquiry to a structural difference from the prior art and then... show[ing] that such a difference alone would have been obvious." Carl Schenck, A.G. v. Nortron Corp., 218 USPQ 698, 700 (Fed. Cir. 1983). Here, the Examiner has indicated that a structural difference from the cited reference, Valerij et al., and the present application is that the prior art includes a processing circuit in the card, while the present application claims, "each information carrier having a passive data storage medium but lacking any data processing unit...". Then, the Examiner impermissibly states that such a difference is obvious because removing this security check would save money. Therefore, for at least this reason, Applicant respectfully submits that the claimed invention is non-obvious over the cited references.

Furthermore, Applicant respectfully submits that "[m]odification unwarranted by the disclosure of a reference is improper." Carl Schenck, A.G. v. Nortron Corp., 218 USPQ 698, 702 (Fed. Cir. 1983). Here, the cited reference does not teach or suggest removal of the electronic circuit 2 of Valerij et al., nor is the missing teaching supplemented.

In fact, the electronic circuit of Valerij et al. is disclosed as being utilized to obtain a higher degree of security against attempted fraud. The electronic circuit is used to decode a random number transferred from the write/read device and to compare it with a non-coded random number transferred from the write/read device. Transmission of data occurs only when the encoded random number is the same as the non-coded random number. Valerij et al., col. 5, lines 52-65.

Additionally, Valerij et al. provide another way for obtaining a high degree of security against fraud including utilizing a signature S as a cryptographic key for encoding and decoding data with the electronic circuit and the write/read device 19. Valerij et al., col. 6, lines 1-45.

Further, the "Summary of the Invention" section of Valerij et al. states, "[t]he object of the invention is to provide a data carrier and an associated write/read device with improved security against forgery, imitation or fraudulent use of the data carrier. According to one aspect of the invention there is provided a data carrier having an electronic circuit for storing and processing data and for communicating with a write/read device...." Valerij et al., col. 1, lines 41-48.

Therefore, it is clear that a principle of operation of the invention Valerij et al. is to provide improved security against forgery, imitation or fraudulent with a data carrier which includes an electronic circuit for processing. The M.P.E.P. explicitly states that "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not

sufficient to render the claims *prima facie* obvious. M.P.E.P. § 2143.01, 2100-127 (rev.1, Feb. 2003) (citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)). Here, the Examiner's proposed change of removing the electronic circuit of the card to save money would clearly change the principle of operation of Valerij et al. which is to provide enhanced security with a data carrier and associated write/read device, not to save money.

Therefore, for at least all of the reasons submitted above, Applicant respectfully submits that Valerij et al. fail to render independent claim 1 obvious. As claims 2-6 and 8-17 depend either directly or indirectly from claim 1, Applicant respectfully submits that these claims are non-obvious over the cited preference for at least the same reasons provided above with regard to claim 1.

#### Conclusion

For at least the reasons submitted above, Applicant respectfully submits that claims 1-6 and 8-17 are in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested.

#### CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313.

Signed: Sally Azevedo  
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Date: May 13, 2004

Respectfully submitted,



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